

REMARKS

Claims 1 through 19 are pending in this application.

I. ALLOWABLE SUBJECT MATTER

In paragraph 10 of Paper No. 10, claims 4, 5, 11, 12, and 16 were objected to as being dependent upon a rejected base claim, but the Examiner stated these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims have been so rewritten (other than those dependent from a rewritten claim). Accordingly, they are now in form to be allowed and the same is respectfully solicited.

II. CLAIM REJECTION UNDER 35 U.S.C. § 103

A. Claim 1

1. In paragraph 2 of Paper No. 10, the Examiner rejected claim 1 under 35 U.S.C. § 103(a) for alleged unpatentability over "Applicant's Admitted Prior Art (Preamble-Jepson Claim)" in view of Sasaki *et al.* U.S. Patent No. 4,787,616.

a. Preliminarily, Lim repeats his denial in Paper No. 9 that he admits that the subject matter of the preamble of his Jepson claim is part of the prior art. There is no rule of law, and none is cited in the office action, that the subject matter of a Jepson preamble is necessarily admitted as prior art. The case-law says that it is not admitted as prior art if the applicant denies the same because, for example, it is his own work. In this case, Lim admits only that the individual elements of the preamble are found separately in the prior art, but not in combination as he has recited them. Combining these elements as stated in the preamble is Lim's own work.

Lim does not contend, however, that combining these prior art elements as described in the preamble would be unobvious under § 103. Nonetheless, as stated above, he believes that no single reference shows them all combined in the manner stated.

By using Jepson format, Lim simply disclaims making any assertion that it was inventive and unobvious to use the elements of the preamble in combination. If it is inventive, Lim dedicates such subject matter with publication of this disclosure, for he regards as the essence or gist of his invention only the combination of such preambular subject matter with the subject matter following the "improvement comprising" clause of the claim. Lim respectfully notes that a concession that each element existed in the prior art and that it would not be inventive to combine them as stated is, in any event, *not* the same thing as a concession that a further jump from that combination to the claimed combination is obvious.

b. The § 103 rejection is reversibly erroneous because important preliminary factual underpinnings of a *Graham v. Deere* analysis are missing here, and so too is the necessary legal analysis that *Gechter v. Davidson*, 116 F.3d 1454, 43 U.S.P.Q.2d 1030 (Fed. Cir. 1997), requires the PTO to build upon the factual underpinnings.

The rejection is based on the ordinary level of skill in the art. Yet, the office actions do not even identify the pertinent art. Even more important, in Paper No. 10, ¶ 12, the Examining Staff for the first time in this case states anything about the level of skill, but what is said is defective: "It is noted that the level of skill is high and individuals in this art typically have advanced degrees." What advanced degrees? Ph.D in Astrophysics? M.S. in Biotechnology? Certificate in Cosmetology? Ph.D in Sociology? How many years of work experience in the pertinent art? Work experience doing what? Where is the substantial evidence of record, see *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001), 1385-86 ("With respect to core factual findings in a determination of patentability" PTO "must point to concrete evidence in the record" and cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense") to support the assertion?

Even if that vague generality quoted above constituted a specific fact finding on

skill level, as required by *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), which it certainly doesn't, findings that the PTO makes on the ordinary level of skill must be supported by substantial evidence of record. *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986) ("Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was."). That is totally lacking here.

That hole in the record alone requires withdrawal or subsequent reversal of the rejection.

c. Paper No. 10, ¶ 12, for the first time in this case now provides an effort to justify the combination of Sasaki's device with the allegedly admitted prior art elements of the preamble of claim 1. But the rationale is defective. The office action states this supposed suggestion, motivation, or teaching in the prior art for combining the references: "to allow Applicant's admitted prior art to perform multiple functions in order to enhance copying capabilities desired by an operator."

But that statement provides no explanation why an artisan would want to combine Sasaki, and not some other structure, with the various hitherto-uncombined elements of Lim's preamble, and not some other elements. There is no rationale in the prior art for combining these specific elements with one another. A statement that the result would "enhance copying capabilities desired by an operator" is just a hindsight observation that the invention is useful. It is not a rationale for making the invention if you have never seen Lim's disclosure and if you lack access to it as a template for making the combination.

Under *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), the rejection is defective for lack of an "essential evidentiary component of an obviousness holding." See also *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d 1321 (Fed. Cir. 1998) ("There must be a teaching or suggestion within the prior art, or within

the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.”); *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998); *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995).

d. Furthermore, even combining Sasaki and the preamble of claim 1 does not provide all of the elements of Lim's “means.” Paper No. 10 misunderstands § 112 ¶ 6 and its case-law when it says (p. 12) that “the features as applicant states is in the specification are not recited in the rejected claim(s).” The reason for that is said (*id.*) to be that “limitations from the specification are not read into the claims.” That statement completely misunderstands *In re Donaldson Co.*, 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(en banc) and *Chiuminatta Concrete Concepts v. Cardinal Indus., Inc.*, 145 F.3d 1303, 46 U.S.P.Q.2d 1752 (Fed. Cir. 1997).

It is not necessary under § 112 ¶ 6 to recite *expressis verbis* in the claims the elements recited in the specification that correspond to the means. Those elements are injected into the claim by virtue of § 112 ¶ 6.

This is not reading limitations into the claim from the specification. The limitations are already *in* the claim because that is how § 112 ¶ 6 operates. *Donaldson* expressly says that.

The two above-quoted statements from Paper No. 10 are each separately reversibly erroneous grounds of claim rejection.

It is the burden of the Examining Staff to establish a *prima facie* case of obviousness. The PTO has the burden of proof, by a preponderance of evidence, to show that an applicant is not entitled to a patent because the claimed subject matter is obvious from the art of record. A patent applicant is entitled to a patent “unless” the PTO establishes otherwise. See, e.g., *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614 (Fed. Cir.

1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). It has not met that burden here and the rejection should therefore be withdrawn.

2. In paragraph 3 of Paper No. 10, claim 1 was further rejected under 35 U.S.C. § 103(a) for alleged unpatentability over Sasaki '616 in view of Takahashi *et al.* U.S. Patent No. 5,379,101 and Arai U.S. Patent No. 6,145,828.

This rejection has the same defects as are discussed in § A-1-b to d, above. Therefore, Lim respectfully incorporates herein by reference his arguments made in those sections above.

On p. 12 (last ¶) of Paper No. 10, for the first time in this case the PTO now provides an effort to justify the combination of Sasaki's device with Takahashi's device. It is said that combining them would save floor space and save time. But why would an artisan select these two specific references to combine, out of the vast number of other possible combinations? That is what *Dembiczak* and similar cases require the Examining Staff to show, and the office action does not remotely begin to do that.

Similarly, for Sasaki and Arai it is said (*id.*) that "one looks to Arai for an operator-accessible way that is noncumbersome...to maintain clearing of sheet jam...." But specifically why does one look to Arai? Where in the prior art is there a *specific* suggestion to look *specifically* to Arai and to combine that device with the other reference(s)? That is what *Dembiczak* and similar cases require the Examining Staff to show, and the office action does not remotely begin to do that.

If the Examining Staff has no answer to the above questions now, how will the Examining Staff find an answer later to put into the Examiner's Answer?

B. Claims 2, 3, 7, 13 to 15, and 18

In paragraph 4 of Paper No. 10, the Examiner rejected claims 2, 3, 7, 13 through

15, and 18 under 35 U.S.C. § 103(a) for alleged unpatentability over applicant's admitted prior art in view of Arai '828.

This rejection has the same defects as are discussed in § A-1-b to d, above. Therefore, Lim respectfully incorporates herein by reference his arguments made in those sections above.

On p. 13 it is said again that "one looks to Arai" as is said in the previous rejection discussed above in § A-2. Again, specifically why does one look to Arai? Where in the prior art is there a *specific* suggestion to look *specifically* to Arai and to combine that device with the other reference(s)? That is what *Dembiczak* and similar cases require the Examining Staff to show, and the office action does not remotely begin to do that. Therefore, Lim respectfully incorporates herein by reference his remarks made above in § A-2.

If the Examining Staff has no answer to the above questions now, how will the Examining Staff find an answer later to put into the Examiner's Answer?

C. Claims 2, 3, 7, 9, 10, 15, and 18

In paragraph 5 of Paper No. 10, the Examiner rejected claims 2, 3, 7, 9, 10, 15, and 18 under 35 U.S.C. § 103(a) for alleged unpatentability over Sasaki '616 in view of Arai '828. This rejection has the same defects as are discussed in § A-1-b to d, above. Therefore, Lim respectfully incorporates herein by reference his arguments made in those sections above.

The only rationale, if it can be so termed, for combining the references is the same non-specific one about looking to Arai, discussed above. Therefore, Lim respectfully incorporates herein by reference his remarks made above in § A-2.

Lim observes further that the statement near the bottom of p. 12 that the claims read on a vast number of structures in 27 subclasses flies in the face of the command of the Federal Circuit in *Donaldson* and *Chiuminatta* that examiners must read the specification to ascertain the scope of a means-plus-function claim, when making a patentability

analysis, since such claims cover only the corresponding structure disclosed in the specification, and equivalents thereof. The paper jam removing means of these claims is not just any imaginable means for removing a paper jam; it is limited to the corresponding structure disclosed in the specification, and equivalents thereof. If that is a vast number of structures in 27 subclasses, why is there not a citation in this record to some of them by patent number?

D. Claims 6 and 7

1. In paragraph 6 of Paper No. 10, the Examiner rejected claims 6 and 17 under 35 U.S.C. § 103(a) for alleged unpatentability over applicant's admitted prior art in view of Arai '828, and further in view of Yim U.S. Patent No. 5,944,307.

As discussed earlier, the preamble is mischaracterized. Lim's remarks in § A-1-a are respectfully incorporated herein by reference. Also, the statement in ¶ 6 that Yim disclosed that "it is well know[n] in the art" is incorrect and unsupported. Yim discloses that it is known, *not* that it is well known.

Nothing of record in this proceeding contains any rationale for the combination of these three references or any subset thereof, to support this rejection. There are no proper findings and no substantial record evidence to support any findings. Therefore, the rejection is unsupportable. *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

Lim also respectfully incorporates herein by reference his remarks made above in § A-1-b to d.

2. In paragraph 7 of Paper No. 10, the Examiner further rejected claims 6 and 17 under 35 U.S.C. § 103(a) for alleged unpatentability over Sasaki '616 in view of Arai '828, and further in view of Yim '307. Lim's response to this is the same as in immediately preceding § D-1. He therefore respectfully incorporates herein by reference such remarks.

E. Claims 8 and 19

1. In paragraph 8 of Paper No. 10, the Examiner rejected claims 8 and 19 under 35 U.S.C. § 103(a) for alleged unpatentability over applicant's admitted prior art in view of Arai '828, and further in view of Mochimaru U.S. Patent No. 4,605,299. Lim's response to this is the same as in preceding § D-1. He therefore respectfully incorporates herein by reference such remarks.

2. In paragraph 9 of Paper No. 10, the Examiner further rejected claims 8 and 19 under 35 U.S.C. § 103(a) for alleged unpatentability over Sasaki '616 in view of Arai '828, and further in view of Mochimaru '299. Lim's response to this is the same as in preceding § D-1. He therefore respectfully incorporates herein by reference such remarks.

F. Claims 2, 9, and 13 vs. 5, 12, 17 - Claim Differentiation

On p. 14, the office action incorrectly asserts that the doctrine of claim differentiation “requires” an independent claim to be interpreted differently than a dependent claim, so that claims 2, 9, and 13 should be interpreted as broader than spring-reciting claims 5, 12, and 17. That is, they should be interpreted as not having a spring structure.

This misstates the doctrine of claim differentiation. It is not a rigid, ironclad rule. It doesn't *require* anything. It is just an aid or guide to interpretation and often gives way, especially in the context of means-plus-function claims. “The dependent claim tail cannot wag the independent claim dog.” *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 U.S.P.Q.2d 1333 (Fed. Cir. 1993). The doctrine of claim differentiation is required to give way to the statutory command of § 112 ¶ 6. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1553, 19 U.S.P.Q.2d 1367 (Fed. Cir. 1991).

In the *Laitram* case, the specification described just an H or X cross structure for joining link ends. Claim 21 required a means for joining link ends, to which the cross structure corresponded. Claim 24, dependent from claim 21, specifically required that the

means have a cross structure. The court held that claim 21 read on H or X cross structures but not V or Z structures, *regardless of claim 24*. The court said that “a means-plus-function limitation is not made open-ended by the presence of another claim specifically claiming the disclosed structure which underlies the means clause....”

What applied to cross structures in that case applies equally to spring structures in this case. The statement in the office action to the contrary is wrong and if permitted to stand would overrule the Federal Circuit's decision in *Laitram*. That makes the instant rejection unsupportable and it should therefore be withdrawn.

In addition, the assertion at p. 14 that a linkage has “some amount of elasticity” and therefore Arai's linkage “reads on the elastic member” is unsupported. The instant specification (p. 12, lines 15-16) describes the elastic member as follows: “an elastic member *such as* a tension coil spring is provided between cover plate 23 and base member 21.” The “such as” means that the member must be *like*, i.e., *ejusdem generis* with, a tension coil spring. Arguably, a cantilever spring or a member that performed the same function in the same way to accomplish the same result would satisfy the requirement of “such as,” but a linkage does not. There is no record evidence to support any suggestion that a metallic linkage like Arai's would operate in the same way in Lim's device as his coil spring does.

Further, “some amount” of elasticity in a linkage is a vague statement without specific content. How much elasticity? A scintilla? A lot? Why would it be enough amount to perform the function required of Lim's spring? Where is the evidence of record to support any such assertion? How is the Examining Staff meeting its burden of proof by a preponderance of evidence, see *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S. P.Q.2d 1614 (Fed. Cir. 1999), that Lim is not entitled to a patent?

The tension coil spring (or an equivalent such as an appropriate cantilever spring member) stores energy when the cover plate 23 and base member 21 are moved relatively,

and by the same token the spring respectively aids or resists such movement of elements 23 and 21, depending on respective direction of motion, so that they can be guided exactly into place or proper registration with one another. This assists in carrying out the function described in the last sentence beginning at the bottom of p. 15 of the instant specification: "Therefore, the position of the multipurpose feeding unit assembly 20 is exactly guided and prevented from being arbitrarily moved forward." A device that did not store energy, such as Arai's linkage of rigid metal parts, *could not do this*. Not only is there no substantial evidence of record to support this basis of this rejection, but it rests on a factual assumption *contrary to common sense*.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$252.00 is incurred by the addition of three (3) independent claims in excess of total 4. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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MARKED-UP VERSION OF AMENDMENTS

IN THE CLAIMS

Please amend claims 4, 11, and 16

1 4 (amended thrice). [The apparatus of claim 3, wherein said paper feeding means
2 comprises:] An electro photo multi functional peripheral apparatus comprising:
3 a main body having an optional auxiliary device located at a first side thereof;
4 a feeding unit for feeding sheets of recording paper, located at a second side of the
5 main body, said feeding unit comprising:
6 at least two cover plates mounted on the upper face of the base mem-
7 ber;
8 a plurality of powered feeding rollers mounted on a rear side of the
9 base member; and
10 a plurality of pinch rollers rotatably mounted at the cover plates and
11 located opposite the feeding rollers; and
12 a feeding unit assembly removably mounted at a central portion of the main body,
13 for transporting the sheets of recording paper which the feeding unit feeds,
14 the feeding unit assembly comprising a jammed paper removing means for
15 easily removing a jammed sheet of paper, said jammed paper removing
16 means comprising:
17 a rectangular base member;

18 at least one cover plate mounted on an upper face of the base member;
19 paper feeding means for feeding the sheets of recording paper, said paper feeding
20 means mounted at the cover plate; and
21 a guiding means for guiding a backward and forward movement of the feeding unit
22 assembly.

1 11 (amended twice). [The method of claim 10, wherein said jammed paper
2 removing means comprises:] A method of facilitating removal of a paper jam in an
3 electro photo multi functional peripheral apparatus comprising:

4 a main body having an optional auxiliary device located at a first side thereof;
5 a feeding unit for feeding sheets of recording paper, located at a second side of the
6 main body;

7 a feeding unit assembly removably mounted at a central portion of the main body,
8 for transporting the sheets of recording paper which the feeding unit feeds,

9 said method comprising the steps of:

10 (1) providing the apparatus with a jammed paper removing means for easily
11 removing a jammed sheet of paper, said jammed paper removing means
12 comprising:

13 a rectangular base member;

14 at least two cover plates mounted on an upper face of the base
15 member;

paper feeding means for feeding the sheets of recording paper, said
paper feeding means mounted at the base member and the
cover plate;

a guiding means for guiding a backward and forward movement of
the feeding unit assembly;

a plurality of powered feeding rollers mounted on a rear side of the
base member; and

a plurality of pinch rollers rotatably mounted at the cover plates and
located opposite the feeding rollers

(2) detecting a paper jam; and

(3) operating the jammed paper removing means in a manner such that the paper
jam is removed.

16 (amended twice). [The process of claim 14,] A process for manufacturing an
electro photo multifunction apparatus, said process comprising the steps of:

(1) providing a main body having an optional auxiliary device located at a first side
thereof;

(2) providing a feeding unit for feeding sheets of recording paper, located at a
second side of the main body; and

(3) providing a feeding unit assembly removably mounted at a central portion of
the main body, for transporting the sheets of recording paper from the feeding unit, the

9 feeding unit assembly having a jammed paper removing means for improved removal of a
10 jammed sheet of paper, said jammed paper removing means comprising:

11 a rectangular base member;

12 at least one cover plate mounted on an upper face of the base member;

13 paper feeding means for feeding the sheets of recording paper, said paper

14 feeding means mounted at the base member and the cover plate; and

15 a guiding means for guiding a backward and forward movement of the

16 feeding unit assembly,

17 wherein:

18 at least one cover plate of said jammed paper removing means comprises a hinge

19 shaft centrally located in said cover plate, said hinge shaft adapted for

20 revolving said cover plate; and

21 [wherein] an elastic spring member is provided between the cover plate and the

22 base member.